

REMARKS

A Notice of Appeal is also enclosed.

Claims 1, 3-6, 9-11, 13, 14, 16-19, and 21-30 are pending in the present application, and

Claims 21-30 have been withdrawn from consideration.

Claims 1, 3, 4, 9-11, 13, 14, and 16-19 are rejected.

Claims 5 and 6 are objected to.

Claims 4 and 11 were amended. Reconsideration of the claims is respectfully requested.

35 U.S.C. § 103 (Obviousness)

Claims 1, 3, 4, 9-11, 13, 14, and 16-19 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Abstract '870 in view of EP '600. This rejection is respectfully traversed.

Claims 4 and 11 are amended to remove informalities noted in the Office Action.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie*

case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The pending Office Action correctly concludes that the Japanese Abstract teaches a main signal line, and sub-signal lines parallel to, on opposite sides of, and in planar arrangement with

the main signal line. However, it should be noted that EP '600 also discloses a main signal line TL, and auxiliary signal lines parallel to, on opposite sides of, and in planar arrangement with the main signal line (see lines 22-33 of page 8, and Figure 10). Accordingly, the Office Action's proposed modification of the Japanese Abstract's 3-conductor arrangement in view of the vertical stack teaching of EP '600 ignores the fact that EP '600 already teaches the same 3-conductor arrangement as taught by the Japanese Abstract. The fact that EP '600 teaches the same 3-conductor arrangement as the Japanese Abstract cannot properly be ignored, because this fact tends to rebut the proposed modification of the Japanese Abstract teaching. After all, EP '600 already teaches the same 3-conductor arrangement as in the Japanese Abstract, and also teaches a 2-conductor vertical stack arrangement (see Figure 10 and lines 22-36 of page 8), yet still fails to teach a 3-conductor vertical stack arrangement. In fact, EP '600 twice specifies that the auxiliary line UAL of Figure 10 is to be disposed above the main line TL. Thus, although EP '600 discloses the advantages of a 3-conductor planar arrangement as also taught in the Japanese Abstract, and also discloses the advantages of a 2-conductor vertical stack arrangement with the auxiliary line UAL disposed above the main line TL, EP '600 nevertheless lacks any indication that a 3-conductor vertical stack would be desirable.

It is impermissible hindsight to pick and choose from a prior art reference only so much of it as will support a desired combination rejection, while excluding other parts of that same reference necessary to a full appreciation of what the reference fairly suggests to one of ordinary

skill in the art. *In re Kamm and Young*, 172 U.S.P.Q. 298 (CCPA, 1972). In this instance, a full appreciation of EP '600 clearly negates any motivation to combine the teachings of EP '600 with the teachings of the Japanese Abstract. It is therefore submitted that the pending obviousness rejections do not meet the criteria of a *prima facie* case, and therefore cannot be maintained.

Therefore, the rejection of Claims 1, 3, 4, 9-11, 13, 14, and 16-19 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: May 13, 2004



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